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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,091	11/02/2001	Joern Ostermann	2000-0600A	5339

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THE LAW OFFICE OF THOMAS M. ISAACSON  
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EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT PAPER NUMBER

2157

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/003,091

Applicant(s)

OSTERMANN ET AL.

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-25, 29 and 30 is/are rejected.  
7) ☒ Claim(s) 26-28 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/3/2005.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application has been reviewed. Original claims 1-29 are pending. The rejection cited stated below.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: the serial numbers of related application are missing. Appropriate correction is required.

#### ***Allowable Subject Matter***

3. Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fail to discloses or suggest a method of delivering a multi-media message to a recipient comprising: determining whether the recipient device has speech synthesis software associated with a voice requested by the sender, if the recipient device does not have the speech synthesis software, synthesizing audio at the server and streaming the audio to the recipient jointly with the available rendering software, if the recipient device does have the speech synthesis software and the requested voice is available, synthesizing the voice at the recipient device and delivering the voice jointly with the available rendering software, if there is speech synthesis software but not the requested voice available, synthesizing the voice at the recipient device and delivering the voice jointly with the available rendering software.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al., U.S. Patent No. 6,393,107[hereinafter Ball] in view of Dutta et al., U. S. Patent No. 6,453,294[hereinafter Dutta].

As per claim 1, Ball discloses a method of delivering a multi-media message to a recipient, the multi-media message being created by a sender and being a message containing for delivery of a text message using text-to-speech means, the method comprising:

receiving the text message (see fig. 1 and col. 4, lines 34-57).

composing the multi-media message using the text message (see col. 4, lines 34-57).

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storing the composed mufti-media message on a server (see col. 4, lines 34-57); and transmitting to the recipient a message containing a link to the multi-media message (see fig. 5 and col. 16, lines 21-35).

Ball is silent regarding: multimedia message containing a talking entity

Dutta in an analogous art discloses a system for delivering multimedia message containing multimedia message containing a talking entity (i.e., animated entity or avatar) (see col. 5, lines 48-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teachings of Dutta such as providing multimedia message containing a talking entity into the system of Ball because including avatars in multimedia messages is known to provide additional details to express personalized opinions, thus enabling multimedia communication to fun and expressive.

As per claim 2, Ball discloses the method of delivering a mufti-media message to a recipient of claim 1, wherein the message contains information regarding the sender of the multi-media message (i.e., obviously including sender's address)(see col.

As per claim 3, Ball discloses the method of delivering a mufti-media message to a recipient of claim 2, wherein the message contains a link to text composed by the sender of the mufti-media message (see col. 14, lines 13-37).

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As per claim 4, Ball discloses the method of delivering a mufti-media message to a recipient of claim 1, further comprising when the recipient clicks on the link (i.e., selects a link), streaming the mufti-media message to the recipient from the server (see col. 14, lines 13-37).

As per claim 5., Ball discloses the method of delivering a mufti-media message to a recipient of claim 1, wherein the link is a URL (see col. 6, lines 55-65).

As per claim 6, Ball discloses the method of delivering a mufti-media message to a recipient of claim 1, 2 wherein the mufti-media message is automatically rendered for the recipient in the client 3 software window (see col. 27, lines 46-52).

As per claim 7, Ball disclose the method of delivering a mufti-media message to a recipient of claim 1, wherein transmitting to the recipient a message containing a link to the mufti-media message further comprises e-mailing the message to the recipient see col. 16, lines 21-35).

As per claim 8 and 14 "official notice" is taken that both the concept and advantage of transmitting a message to a recipient using instant messaging is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the to utilize instant messaging to deliver messages because instant messaging system is known to deliver messages faster, thus ensuring reliable communication.

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As per claim 9, the claim includes features discussed with respect to claim 1, further reciting:

transmitting the multi- media message from the server in a first part and a second part (see col. 10, lines 15-33 and col. 23, lines 16-34).

As per claim 10-13, Ball discloses the method of delivering a mufti-media message to a recipient of claim 9, wherein the first part comprises only the text of the sender message and wherein the second part contains the URL to present the mufti-media message in a message window and wherein the second part further contains a second link to the server containing the multi- media message part (see col. 10, lines 15-33 and col. 23, lines 16-34).

As per claim 15, Ball discloses the method of delivering a mufti-media message to a recipient of claim 9, wherein transmitting to the recipient a message containing a link to the mufti-media message further comprises transmitting the message via a wireless communication link (i.e., a communications network 105, which might obviously include a wireless link)( see fig. 1).

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8. Claims 16-17, 21-25, and 29-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Ball in view of Krueger et al., U.S. Patent No. 6,496,868[hereinafter Krueger].

As per claim 16 and 21, Bal discloses a method of delivering a mufti-media message to a recipient, the mufti-media message being created by a sender, the method comprising:

maintaining at a server a database (92)of recipient e-mail addresses and available rendering software associated with each e-mail address (see figs. 3 and 9 and col. 9, lines 22-30 and col. 25, lines 51-62);

upon receiving a mufti-media message from a sender to a recipient and using the database(see col. 4, lines 34-57).

Ball is silent regarding: determining whether the recipient has rendering software for delivering the

mufti-media message;

if the recipient has rendering software, delivering the mufti-media message using the rendering software; and

if the recipient does not have rendering software, streaming the mufti-media message from the server such that a generic rendering software device will deliver the mufti-media message.

Krueger in analogous art discloses a method for transcoding an audio data on behalf of client based on the client capability including the step of:

determining whether the recipient has rendering software for delivering the



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mufti-media message (see col. 5, lines 51 to col. 6, line 6 and col. 6, line 55 to col. 7, line 3);

if the recipient has rendering software, delivering the mufti-media message using the rendering software(see col. 5, lines 51 to col. 6, line 6 and col. 6, line 55 to col. 7, line 3);

and if the recipient does not have rendering software, streaming the mufti-media message from the server such that a generic rendering software device will deliver the mufti-media message (see col. 5, lines 51 to col. 6, line 6 and col. 6, line 55 to col. 7, line 3). Therefore, it would have been obvious to having ordinary skill in the art at the time of the invention presented the teaching of Ball to incorporate the teaching of Krueger to determine client capabilities before transmitting the multimedia message, thus ensuring multimedia messages be transcoded according client capabilities.

As per claim 17, Krueger discloses the method of delivering a mufti-media message to a recipient of claim 16, further comprising, regardless of the determination of whether the recipient has available rendering software for delivering the mufti-media message, presenting the recipient with an option to receive a streaming mufti-media message from the server(see col. 5, lines 51 to col. 6, line 6 and col. 6, line 55 to col. 7, line 3).

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9. Claims s 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball and Krueger as applied to claim 1 above, and further in view of in view of Cain U.S. Patent No. 6,680,934.

As per claims 18-20, Ball and Krueger disclose substantial features of the claimed invention as discussed above with respect to claim 16.

Ball and Krueger are silent: wherein a high-priority queue and a low priority queue are used to deliver mufti-media messages.

Cain disclose a message distribution for using customized rules to distribute messages including using a high-priority queue and a low priority queue to deliver mufti-media messages (see fig. 4, and col. 3, lines 6-40). Therefore, it would have been obvious to one having ordinary in the art at the time of the invention to incorporate the teaching of Cain such as using high-priority queue and a low priority queue to deliver mufti-media messages into the combined system of Ball and Krueger because priority-level queues provide increased flexibility in message classification.

As per claim 22, Krueger discloses the method of delivering a mufti-media message to a recipient associated with a client device of claim 20, wherein delivering the mufti-media message further comprises delivering an audio portion of the mufti-media message based on the client device capabilities (col. 6, line 6 and col. 6, line 55 to col. 7, line 3).

As per claims 23-25, the claims include limitations analogous to those in claims 16-22 and rejected same rational as claims 16-22.

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**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 571-272-4009. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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2/3/2005